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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,161	02/06/2007	Martin Steinwender	20496-514	7769
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PROSKAUER ROSE LLP ONE INTERNATIONAL PLACE BOSTON, MA 02110				
EXAMINER				
BELL, WILLIAM P				
ART UNIT		PAPER NUMBER		
1745				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/574,161

Applicant(s)

STEINWENDER ET AL.

Examiner

WILLIAM P. BELL

Art Unit

1745

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2010.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10, 11, 13-19 and 30-37 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1, 10, 13-19 and 30-37 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB06)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ ~~Notice of Informal Patent Application~~
6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 10, 11, 13, 30, and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Maldas (U.S. Patent Application Publication No. US 2006/0006564). Regarding claim 10, Maldas teaches a process for the production of a structural part from a compound of a thermoplastic synthetic material and a strengthening component (see [0026]), wherein the thermoplastic synthetic material of the compound comprises polyethylene terephthalate (see [0081]) and the strengthening component comprises organic filler (see [0080]), and wherein the process comprises the steps of producing the structural part through thermoplastic conversion (see [0087]) and post-processing the structural part by a double band press downstream of the thermoplastic conversion (see [0087]).

Regarding claim 11, Maldas teaches a process wherein a board-shaped structural part is produced (see Abstract, wherein a panel is a board-shaped structural part).

Regarding claim 13, Maldas teaches a process wherein a rope-shaped structural part is produced (see Abstract, wherein a profile is produced; applicant recites extruded profiles as examples of rope-shaped parts; see page 7, paragraph 2 of instant application).

Regarding claim 30, Maldas teaches a process wherein thermoplastic conversion comprises extrusion or injection molding (see [0087]).

Regarding claim 31, Maldas teaches a process wherein the polyethylene terephthalate is collected from used PET products (see [0081]).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 14 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maldas (US 2006/0006564) as applied to claim 10 above, and further in view of Matsumoto (U.S. Patent Application No. US 2002/0192401, already of record). Maldas is silent regarding providing at least one surface of the structural part with a coating. Matsumoto teaches a process for the production of a structural part (see [0019] and [0161]) from a compound of polyethylene terephthalate (see [0070]) and organic filler (see [0071]) wherein the structural part is produced through thermoplastic conversion (see [0101]). Matsumoto further teaches that at least one surface of the structural part

is provided with a coating (see [0078]) in a liquid form of an artificial resin (see [0078] and [0088]-[0092]) that is applied by means of co-extrusion (see [0150]-[0153] and Figures 1 and 2, wherein the disclosed process constitutes a co-extrusion process because both the composite material and the coating material are extruded and formed into a single product in a single process). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the process of Maldas with the coating process of Matsumoto for the benefit of blocking the release of trace colored components in the filler so that no fading or discoloration takes place in the structural part even on long-term outdoor exposure (see Matsumoto, [0078]).

5. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maldas (US 2006/006564) as applied to claim 10 above, and further in view of Medoff (U.S. Patent No. 6,207,729, already of record). Maldas is silent regarding providing at least one surface of the structural part with a coating. Medoff teaches a process for production of a structural part (see column 5, lines 33-65) from a compound of polyethylene terephthalate (see column 4, line 52) and an organic filler (see column 3, lines 8-19) wherein the structural part is produced through thermoplastic conversion (see column 5, lines 50-58). Medoff further teaches that the structural part is provided with a coating in the form of a veneer (see column 6, lines 42-43). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the process of Maldas with the veneer coating of Medoff for the benefit of providing a structural article with a decorative veneered surface.

6. Claims 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maldas as applied to claim 10 above, and further in view of Shah (U.S. Patent No. 6,028,212, already of record). Maldas is silent regarding providing at least one surface of the structural part with a coating. Shah teaches that it is known to provide wood composites with powder coatings (see column 8, lines 39-41). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the process of Maldas with the powder coating of Shah for the benefit of providing the structural part with decorative effects and/or UV or water protection, all of which are well known uses for powder coatings.

7. Claims 32-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumoto (US 2002/0192401) in view of Nishibori (European Patent Application Publication No. EP-066375, already of record). Regarding claim 32, Matsumoto teaches a process for the production of a structural part (see [0019] and [0161]) from a compound of a thermoplastic synthetic material (see [0070]) and a strengthening component (see [0020]), wherein the thermoplastic synthetic material of the compound comprises polyethylene terephthalate (see [0070]) and the strengthening component comprises organic filler (see [0071]), and wherein the process comprises the steps of producing the structural part through thermoplastic conversion (see [0101]). Matsumoto is silent regarding post-processing the structural part by a calendering device downstream of the thermoplastic conversion. Nishibori teaches that it is known in the prior art to calender synthetic wood boards after extrusion (see page 3, lines 18-27). It would have been obvious to one of ordinary skill in the art at the time of the invention to

have applied a calendering device to the synthetic wood board taught by Matsumoto for the benefit of rolling the board to a predetermined thickness (see Nishibori, page 3, line 26).

Regarding claim 33, Matsumoto teaches a process wherein a board-shaped structural part is produced (see [0152]).

Regarding claim 34, Matsumoto teaches a process wherein a rope-shaped structural part is produced (see [0165], wherein an extruded profile is produced; applicant recites extruded profiles as examples of rope-shaped parts; see page 7, paragraph 2 of the instant application).

Regarding claim 35, Matsumoto teaches a process wherein at least one surface of the structural part is provided with a coating (see [0078]).

Regarding claim 36, Matsumoto teaches a process wherein thermoplastic conversion comprises extrusion or injection molding (see [0069]).

Regarding claim 37, Matsumoto teaches a process wherein the polyethylene terephthalate is collected from used PET products (see [0070]).

Response to Arguments

8. Applicant's arguments filed 7 September 2010 have been fully considered but they are not persuasive. Applicant argues that Nishibori teaches away from the proposed modification of Matsumoto with a calendering device because Nishibori teaches that some aspects of a calendering device may have detrimental effects. Examiner respectfully disagrees. In the rejection of claim 32, Nishibori is used solely as

evidence of the state of the art at the time of the invention. Nishibori clearly teaches that it was known at the time of the invention to calender composite wood products to obtain a desired thickness. Thus, based on the level of knowledge of one ordinary skill in the art at the time of the invention, it would have been obvious to have used calendering device in the process of Matsumoto, regardless of what Nishibori teaches as supposed advantages of his invention.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **WILLIAM P. BELL** whose telephone number is

(571)270-7067. The examiner can normally be reached on Monday - Thursday, 8:00 am - 5:30 pm; Alternating Fridays, 8:00 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Philip Tucker can be reached on 571-272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/WILLIAM P BELL/
Examiner, Art Unit 1745

/Philip C Tucker/

Supervisory Patent Examiner, Art Unit 1745